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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,361	07/11/2001	Katsushi Saito	F-7057	5451

7590

07/28/2003

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 07/28/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

# Office Action Summary

Application No.

09/903,361

Applicant(s)

SAITO ET AL.

Examiner

Christopher P Bruenjes

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-- Th MAILING DATE of this communication app ars on the cov r she t with the correspondenc address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14,17,18 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14,17,18 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The declaration under 37 CFR 1.132 filed July 9, 2003 is insufficient to overcome the rejection of claims 1-14, 17-18, and 26 based upon 35 U.S.C. 102 and 103 as set forth in the last Office action because:

The allegation that process oils sold as paraffinic process oils containing aromatic content in excess of 13% is not backed up with any evidence to support the allegation, therefore it is not known if the paraffinic process oils are commonly sold with more than 13% aromatic content or if these paraffinic process oils with a high aromatic content are rare and seldom used. Konegen discloses that paraffinic process oil is used as a material forming the resin boot, and it is not understood without evidence of common process oils sold with aromatic contents in excess of 13%, why Konegen wasn't teaching paraffinic process oils with an aromatic content less than 13%.

Further, it is well settled that unexpected results must be established by factual evidence. Applicant must provide experimental data comparing the instant invention to the closest prior art, in this case Konegen, to show unexpected result. Merely stating that a certain limitation, such as the aromatic

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content of the process oil, produces a boot with unexpected improvements is not found persuasive without experimental evidence to support the allegation. Also, any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. In this case in order to support an allegation of unexpected result, evidence must be provided showing unexpected result such as a greater than expected result or an unexpected property for the boot with an aromatic content of slightly less than 13% and a boot with an aromatic content slightly more than 13%. This evidence is needed to show that the aromatic content of less than 13% provides unexpected result compared to the prior art. See MPEP 716.02.

#### **WITHDRAWN REJECTIONS**

2. The objections to the specification and claims 1 and 9 of record in Paper #8, Pages 2-4 Paragraphs 3-5 have been withdrawn due to Applicant's amendment in Paper #11.

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3. The 35 U.S.C. 112 rejections of claims 1-18 and 26 of record in Paper #8, Page 5 Paragraph 6 have been withdrawn due to Applicant's amendment in Paper #11.

**REPEATED REJECTIONS**

4. The 35 U.S.C. 102 rejections of claims 1 and 9-14 as anticipated by Konegen are repeated for the reasons previously of record in Paper #8, Pages 6-7 Paragraph 7.

5. The 35 U.S.C. 103 rejections of claims 2-8 and 17-18 over Konegen in view of Berendse are repeated for the reasons previously of record in Paper #8, Pages 8-10 Paragraph 9.

6. The 35 U.S.C. 103 rejection of claim 26 over Konegen in view of Kahoki is repeated for the reasons previously of record in Paper #8, Pages 10-11 Paragraph 10.

**ANSWERS TO APPLICANT'S ARGUMENTS**

7. Applicant's arguments filed in Paper #11 and 13 regarding the 35 U.S.C. 102 rejections of claims 1 and 9-14 as anticipated by Konegen have been fully considered but they are not persuasive.

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In response to Applicant's argument that Konegen does not recite a flexible resin boot structure molded from a mixture of thermoplastic resin and mineral oil, it is noted that the newly amended claim 1 does not recite that limitation. The current claim recites that the structure is "formed of a material" comprising thermoplastic elastomer and mineral oil. Konegen teaches a resin boot formed from thermoplastic elastomer impregnated with mineral oil, therefore teaches a structure formed of or comprising thermoplastic elastomer and mineral oil.

In response to Applicant's argument that Konegen doesn't teach a paraffinic mineral oil having an aromatic content less than 13%, Konegen teaches using paraffinic oil, which alone does not contain any aromatic content. Applicant has alleged in a rule 132 declaration that process primary oils many times have other oils mixed in when sold, however, no factual evidence was provided to support this allegation and no evidence to support the belief that the paraffinic oil recited by Konegen actually is paraffinic oil mixed with aromatic oil giving the oil an aromatic content greater than 13%.

8. Applicant's arguments filed in Paper #11 regarding the 35 U.S.C. 103 rejections of claims 2-8 and 17-18 over Konegen in

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view of Berendse have been fully considered but they are not persuasive.

In response to applicant's arguments that the combination of references does not teach all that is claimed in claim 1, Konegen teaches all that is claimed in claim 1 as discussed in the answer to arguments regarding the 35 U.S.C. 102 rejections above.

9. Applicant's arguments filed in Paper #11 regarding the 35 U.S.C. 103 rejection of claim 26 over Konegen in view of Kahoki have been fully considered but they are not persuasive.

In response to applicant's arguments that Kahoki doesn't teach that the paraffin oil and naphthene oil is added as a mixture to a thermoplastic elastomer in order to reduce friction, the fact that Applicant uses the mixture of paraffin oil and naphthene oil for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference. See *In re Lintner*, 173 USPQ 560.

In response to applicant's arguments that the combination of references does not teach all that is claimed in claim 1, Konegen teaches all that is claimed in claim 1 as discussed in

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the answer to arguments regarding the 35 U.S.C. 102 rejections above.

10. Applicant's arguments filed in Paper #11 regarding claims 27 and 28 are moot since the claims have been cancelled.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440.



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The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB

July 23, 2003



ALEXANDER S. THOMAS  
PRIMARY EXAMINER